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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,484	03/25/2004	Colin C.O. Goble	2558-78	5758
23117	7590	03/07/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			PATEL, NIHIR B	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/808,484	Applicant(s) GOBLE ET AL.	
	Examiner Nihir Patel	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 22-24, 34 and 36-40 is/are rejected.
- 7) ☒ Claim(s) 4, 9-21, 25-33 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Davison et al. (US 6,632,193).
3. As to claims 1-6, 22-24, 36, 37, 38 and 39, Davison teaches an electro-surgery system for treating tissue immersed in an electrically conductive fluid, comprising a generator for delivering a radio frequency tissue treatment output in the frequency range of from 100kHz to 50 MHz (see column 21 lines 1-10), and an elongate instrument shaft configured to be mounted at a proximal end to a hand-piece and carrying at its distal end a bipolar electrode assembly connected to the generator (see column 23 lines 58-67 and column 24 lines 1-7), wherein the electrode assembly includes: an active electrode with an active zone at a distal end of the active electrode ; and a return electrode with a return zone near the active zone; wherein at least one of the active and return zones has an electrically insulating dielectric covering such that in use a radio frequency electrical circuit between the active and return electrodes through the conductive fluid is completed preliminary by dielectric coupling through the dielectric covering (see column 23 lines 58-67 and column 24 lines 1-7).

4. **As to claims 2 and 23**, Davison teaches an electro-surgery system for treating tissue immersed in an electrically conductive fluid wherein the return zone is adjacent and set back from the active zone in the proximal direction (see **column 23 lines 58-67 and column 24 lines 1-7**).
5. **As to claims 3 and 24**, Davison teaches an electro-surgery system for treating tissue immersed in an electrically conductive fluid wherein the insulating covering encases the return zone, and the active zone is exposed (see **column 23 lines 58-67 and column 24 lines 1-7**).
6. **As to claims 5 and 7**, Davison teaches an electro-surgery system for treating tissue immersed in an electrically conductive fluid wherein the frequency of operation of the generator and the construction of the electrode assembly are such that application of radio frequency power by the generator to the electrode assembly results substantially uniform distribution of electric field over the return zone and a corresponding substantially uniform current density of the electric field (see **column 3 lines 65-67 and column 4 lines 1-15**).
7. **As to claim 6**, Davison teaches an electro-surgery system for treating tissue immersed in an electrically conductive fluid wherein both the active zone and the return zone are encased in respective dielectric insulative dielectric coverings so that the active zone is insulated from direct electrical contact with the tissue and the electrically conductive fluid in use, a circuit is completed between the active and return electrodes primarily by dielectric couplings through both coverings (see **column 23 lines 58-67 and column 24 lines 1-7**).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3743

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims **8, 34 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Davison et al. (US 6,632,193) in view of Ellsberry et al. (US 6,432,103).
3. **As to claims 8, 34 and 40**, Davison discloses the applicant's invention as claimed with the exception of providing low loss dielectric material (ceramic) for each dielectric covering. Ellsberry discloses an apparatus that does provide an electro-surgery system for treating tissue immersed in an electrically conductive fluid. Therefore it would have been obvious to modify Davison's invention by providing an electro-surgery system for treating tissue immersed in an electrically conductive fluid as taught by Ellsberry in order to improve the insulation between the two electrodes.

Allowable Subject Matter

Claims **4, 9-21, 25-33 and 35** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

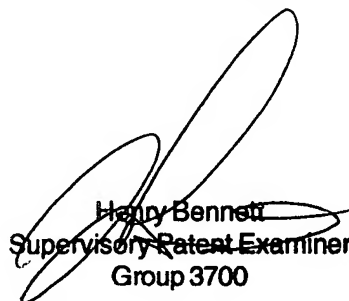
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nihir Patel
Art Unit 3743


Henry Bennett
Supervisory Patent Examiner
Group 3700